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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/765,137	01/18/2001	Lloyd Adams	JPM-052	7821

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Intellectual Property Department  
Goodwin/Procter LLP  
901 New York Avenue, NW  
Washington, DC 20001

EXAMINER
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AKINTOLA, OLABODE

ART UNIT	PAPER NUMBER
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3691

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08/30/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/765,137	<b>Applicant(s)</b> ADAMS ET AL.	
	<b>Examiner</b> OLABODE AKINTOLA	<b>Art Unit</b> 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,3-7 and 9-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-7 and 9-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 3-6, 14-15 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Riseman (US 7395239) in view of Norris (US 5870721).

Re claims 1 and 6: Riseman teaches a system and corresponding method for producing and sending a loan document to a customer, the system comprising: a web-enabled customer interface which receives loan information from the customer (col. 4, lines 37-51, fig. 1); a network coupled to the customer interface, the network receives the loan information from the customer interface (col. 4, line 52 through col. 5, line 17, fig. 1); a web site coupled to the network, the web site prompting the customer to enter the loan information, receiving the loan

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information and merging the loan information with a loan application form to produce a loan application (col. 4, lines 37 through col. 5, line 17, fig. 1); a loan processor computing system hosting the website and storing the loan application form, the loan processor computing system receiving the loan application, automatically performing a credit check on the customer based on the loan application, the loan processing computing system determining whether the is approved (col. 5, lines 31-40, col. 6, lines 20-23);

Riseman does not explicitly teach the concept of performing a credit check by sending a loan application to a credit approval agency; a loan forms database storing forms used in the creation of loan documents and; a loan document creation server coupled to the loan processor computing system and the loan forms database, wherein the loan processor computing system, upon approving the loan application, automatically forwards the loan application to the loan document creation server, the loan document creation server generating and sending the loan document to the customer, based on the loan application and the accessed loan forms in the loan forms database, the loan document creation server sending the loan document to the customer through one of e-mail, facsimile, the network, a first printer coupled to the network, and a second printer coupled to another network. However, Riseman teaches that after the final approval of the loan, the remaining steps of the loan process are accomplished by traditional methods (col. 7, lines 23-35).

Norris teaches the concept of performing credit check by sending a loan application to a credit approval agency (“*neural network 17*”)(col. 6, lines 8-45, fig. 1); a loan approval determination based on credit check; and generating and sending loan agreement and related documentation to the customer via facsimile (see at least abstract, col. 2, lines 13-15 and 35-39). Furthermore,

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Norris teaches if the user has a personal computer, modem and a printer, an “electronic file of the documents” can be transmitted to the user (col. 4, lines 61-63). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Riseman to include these features as taught by Norris for the obvious reason of ensuring that the applicant is credit worthy and for speedy transmittal of all related and necessary documents between the lender and customer which are normally accomplished by traditional methods.

Re claim 3: Riseman teaches wherein: the network is the internet; and the customer interface is one of a computer, a personal digital assistant, and a loan application kiosk (fig. 1).

Re claim 4: Riseman does not explicitly teach, wherein the loan document includes at least one of a check and data relating to an electronic transfer of funds relating to the loan. However, Riseman teaches arranging for loan payments to be made automatically by electronic funds transfer (col. 7, lines 34-35). Norris teaches a loan documentation and electronic withdrawal from applicant’s account to repay the loan (col. 2, lines 13-15). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Riseman to include these features as taught by Norris for the obvious reason of establishing repayment method for the loan.

Re claims 5, 17-19: Riseman and Norris combination does not explicitly teach, wherein the loan document includes insurance information relating to the loan, a loan approval letter, a loan promissory note, a loan contract. Official notice is hereby taken that including these documents

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as part of loan documentation is old and well known. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Riseman and Norris combination to include these documents for the obvious reason of providing the applicant with all the necessary documents regarding the loan as may be required by law.

Re claims 14-15: Riseman and Norris combination teaches wherein the loan application is received by the loan processor computing system before the loan document is generated; wherein the loan application is produced before the loan document is generated (see claims 1 and 6 analyses, supra).

Re claim 20: Riseman and Norris combination does not explicitly teach verifying a customer account by sending a test transaction; and sending funds to a customer account after the customer account is verified. Official notice is hereby taken that this concept is old and well known. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Riseman and Norris combination to include this feature for the obvious reason of verifying the customer account by allowing the lender to ensure that the account to which money is deposited actually belongs to the customer, thereby preventing fraud or error.

Claims 7-13 and 16 rejected under 35 U.S.C. 103(a) as being unpatentable over Riseman and Norris as applied to claims 1-6, 14, 15 and 17-19 above, and further in view of Cohen et al (USPN 5740035).

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Re claims 7 and 13: Riseman and Norris teach all the claimed limitations as discussed above with respect to claims 1-6, 14, 15 and 17-19. Riseman and Norris do not explicitly teach analyzing the received loan information for completeness and prompting the customer if the received loan information is incomplete; sending a check to the customer, the check corresponding to the loan contract, receiving the check and cashing a check whereby cashing the check indicates acceptance by the customer of the terms listed in the loan document, checking the validity of the check. However, Riseman and Norris both teach electronic transfer of funds. Cohen teaches the concept of analyzing received information for completeness and prompting the user if the received information is incomplete (col. 4, lines 22-31). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Riseman to include this prompting the user when the received information is incomplete for the obvious reason of ensuring that all information necessary to process the application are received. Official notice is hereby taken that substituting EFT for a physical check and cashing the check to indicate acceptance by the customer of the terms listed in the loan document, checking the validity of the check and verifying the customer account by sending a test transaction are old and well known.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Riseman in view of Norris to include these features. One would have been motivated to do so in order to allow the customer to receive the funds and accept the loan by cashing the check.

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Re claim 9: Riseman teaches wherein receiving loan information includes receiving the loan information over a network (fig. 1).

Re claim 10: Riseman teaches wherein: the network is the Internet; and receiving loan information includes receiving loan information from the customer through one of a computer, a personal digital assistant, and a loan application kiosk (fig. 1).

Re claims 11 and 12: Riseman and Norris combination teaches, wherein the sending of the loan document includes sending the loan document to the customer through one of e- mail, facsimile, the network, a first printer coupled to the network, another network, and a second printer coupled to the another network (see claims 1, 6 and 14-15 analyses, supra).

Re claim 16: Riseman and Norris combination teaches wherein the loan information is received before the loan document is generated (see claims 1 and 6 analyses, supra).

### ***Response to Arguments***

Applicant's arguments filed 7/14/2010 have been fully considered but they are not persuasive.

Applicant argues that Riseman and Norris fails to teach merging loan information with loan application form to produce a loan application and performing credit check by sending the loan application to a credit approval agency. Applicant requests that Examiner identify (a) loan information, (b) loan application form, and (c) loan application as required in claim 1. In



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response, the loan information is the information provided by the applicant, the loan application form is the web form the is accessed via the lender's web site, and the loan application is the completed loan form after the applicant enters data and is stored in a database (electronic loan application)(col. 5, lines 23-25).

Applicant also argues that MSS performs all the processing steps, thereby eliminating the need to forward the "loan application". However, one of ordinary skill in the art would recognize the advantage of sending the application to a credit agency (another application or processor) for determining whether the customer should receive a loan based on the credit report rather than having the MSS take that decision. Such advantage includes splitting various tasks that is performed by one application (MSS) between multiple applications for faster processing and decision making.

Examiner admits that Riseman does not explicitly teach that the system performs a credit check by sending the "loan application" to a credit approval agency. However, Norris teaches this concept (see col. 6, lines 8-45, fig. 1).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

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In this case, one of ordinary skill in the art would recognize the advantage of sending the application to a credit agency (another application or processor) for determining whether the customer should receive a loan based on the credit report rather than having the MSS take that decision. Such advantage includes splitting various tasks that is performed by one application (MSS) between multiple applications for faster processing and decision making.

Furthermore, Applicant argues that Norris does not send loan application to the credit bureau or approval agency. Examiner respectfully disagrees. Norris explicitly teaches that the computer sends the “loan application” (interpreted simply as information entered by the applicant such as name, address and social security number which are considered as non functional descriptive material) to the credit bureau which sends a credit report to the computer (col. 2, lines 21-27, “*Information about the applicant is also obtained ..... from credit bureau that provided credit reports on an applicant given a name, a social security number and an address*”). The computer (containing “neural network” capability) then determines whether to approve the loan (col. 2, lines 27- 34). Examiner notes that the differences between the “loan application” of the prior art and the claimed limitation are only rooted in content. And content is nonfunctional descriptive material. Patentable weight need not be given to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate, of which there is no evidence in the record. See *In re Lowry*, 32 F.3d 1579, 1582-83 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004). See also *Exparte Mathias*, 84 USPQ2d 1276, 1279 (BPAI 2005) (nonprecedential) (Federal Circuit Appeal No. 2006-1103; 191 Fed. Appx. 959 (Fed. Circ. 2006) affirmed without written opinion Aug. 17, 2006).

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Examiner notes that the concept of receiving credit report or credit score from various bureau databases (Equifax, TransUnion and Experian) requires certain data about the applicant (such as name address social security number (“loan application”)) in formats compatible with that used by the credit bureaus. *See for example, Lent et al (US 6405181) at fig. 1, col. 1, lines 31-65 and col. 2, lines 4-10* for background information on how this is done.

Applicant further argues that Riseman and Norris fail to teach a loan form database storing forms used in the creation of loan documents; and a loan document creation server coupled to the loan processor computing system and the loan forms database, wherein the loan processor computing system, upon approving the loan application, automatically forwards the loan application to the loan document creation server, the loan document creation server generating and sending the loan document to the customer. Specifically, Applicant asserts that Norris provides these documents to the customer using traditional methods outside of the closed loop automated process. Examiner respectfully disagrees. Norris explicitly teaches that the term ““closed loop” means that **all** the steps involved in loan processing, including the steps of transferring the funds to the borrower and arranging for repayment as well as completing the loan application and underwriting it can be done without human intervention” (col. 2, lines 3-7). Norris further teaches that electronic file of loan documents can be transmitted to the borrower (col. 4, lines 61-63). Therefore, Norris inherently teaches that the aforementioned limitations are an integral part of the “closed loop” process.

Applicant further argues that the form is selected from a plurality of forms. Examiner asserts that the specification has no support for this limitation. Examiner interprets the plurality

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of forms to be plurality of web pages that the all applicants need to complete to create an application.

In response to applicant's argument that Riseman reference is related exclusively to mortgages while the Norris reference is directed to general loan application processing, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

The fact that the Riseman is related to mortgage processing does not mean that the method described in Riseman can not be applied to other types of loan processing. The method described would be the same regardless of the type of loan being processed.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OLABODE AKINTOLA whose telephone number is (571)272-3629. The examiner can normally be reached on M-F 8:30AM -5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Olabode Akintola/  
Primary Examiner, Art Unit 3691

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